

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
Samantha H. Stetson, et al.)
) Examiner: Raquel Alvarez
Application No: 10/092,369)
) Art Unit: 3682
Filed: March 6, 2002)
) Confirmation No: 8236
For: METHOD AND APPARATUS FOR)
SERVING A MESSAGE IN)
CONJUNCTION WITH AN)
ADVERTISEMENT FOR DISPLAY ON)
A WORLD WIDE WEB PAGE)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons stated on the attached sheets.

This request is being filed with a Notice of Appeal.

If there are any additional fees due in connection with this communication, please charge Deposit Account No. 19-3140.

Respectfully submitted,
SNR DENTON US LLP

Date: October 11, 2011

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STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

1. STATUS OF CLAIMS

Claims 1, 8, 11-13, 16-19, 21-22, 24, 26, 31, 33, 35, 37, 72 and 74 are presently pending, have been finally rejected, and the subject of this Pre-Appeal Request for Review.

2. GROUNDS OF REJECTIONS TO BE REVIEWED

Claims 1, 8, 11-13, 16-19, 21-22, 24, 26, 31, 33, 35, 37, 72 and 74 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Thomas, (U.S. Patent No.: 6,128,663, hereinafter “Thomas”) in view of the Official Notice.

This ground of rejection is the sole subject for this Pre-Appeal Request for Review.

3. ARGUMENT

The pending claims are distinguishable over Thomas because they require a tailored message that includes personal information and directs the user's attention to a banner advertisement, neither of which are taught or suggested in Thomas or by the Official Notice cited in the Final Office Action.

When “determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP Section 2141.02 citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) and *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), emphasis in the original. The Final Office Action only states that Thomas renders the feature “tailoring said message based on said targeting criteria and serving said tailored message for display on said World Wide Web page” obvious and is silent with regard to the features of tailoring a message to include personal information and direct the user’s attention to the banner advertisement recited in the present claims. Thus, it appears these features have not been considered when examining the invention as a whole under the standard stated above.

- tailoring said message (182) based, at least in part, on said targeting criteria and said personal information to include a portion of said personal information (the user's name, "Samatha") and direct the user's attention to the banner advertisement ("get great gifts with iWon Cash Points. Check it out!!"); and
- serving said tailored message (182) for display to said user on said World Wide Web page (180) separate from said banner advertisement (152), wherein the tailored message (182), at least a portion of the content other than the banner advertisement included in said World Wide Web page, and the banner advertisement (152) are simultaneously displayed to the user.



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describes providing a World Wide Web page that includes a banner advertisement, a set of search results, and a message directing a user's attention to the search results as depicted in Figure 11 (annotated below).

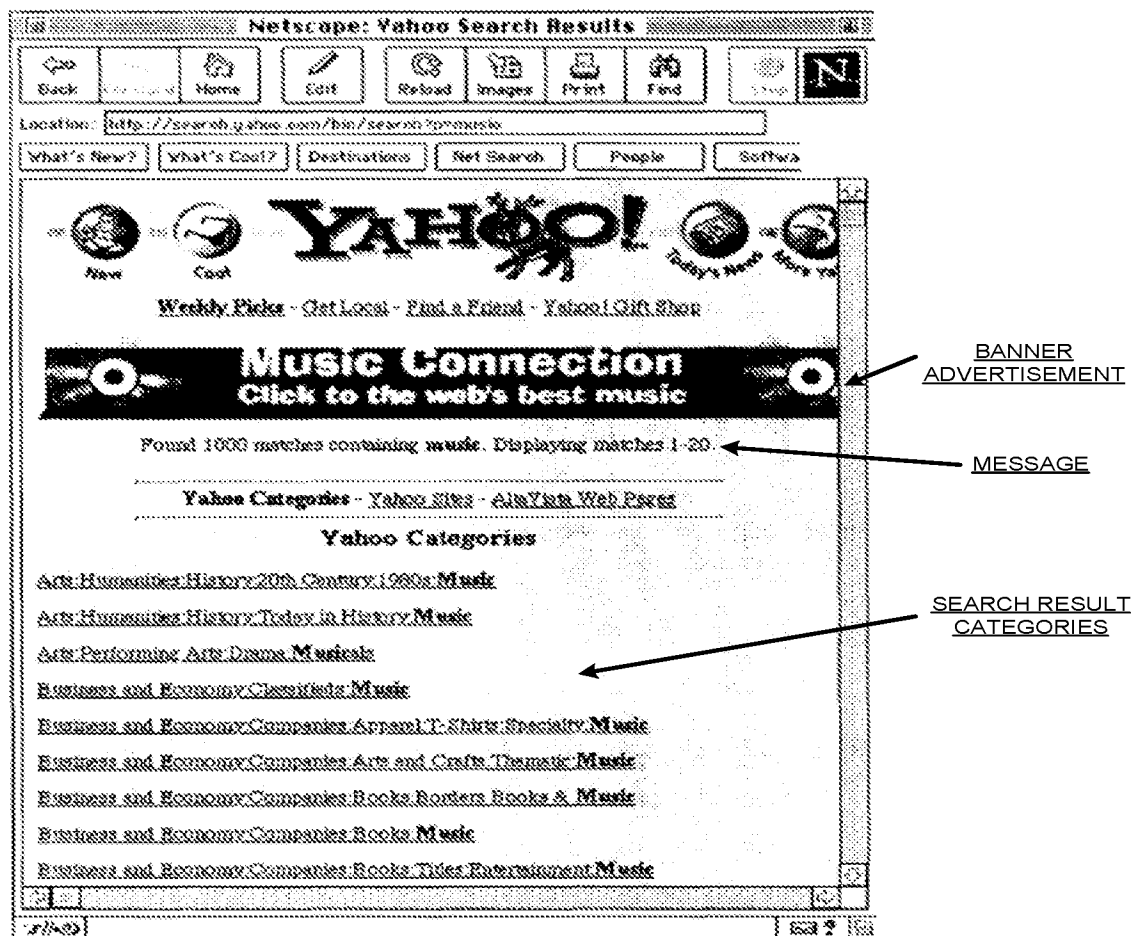


FIG. 11

Consequently, although Thomas discloses the display of a banner advertisement and a message, that message directs the user's attention away from the banner advertisement and toward search result categories, and therefore not only has the opposite effect of the message recited in the present claims but also fails to suggest the very feature of the claims for which it is being cited. In addition, the message of Thomas fails to include any personal information about a user.

Furthermore, Thomas simply does not teach or suggest any selection or customization of content or any provided greeting or variant of a World Wide Web page that includes personal information or directs a user's attention to a banner advertisement as presently claimed. The Official Notice cited in the Final Office Action does not address or overcome these deficiencies.

Hence, for at least these reasons the present claims are patentable over Thomas, even when considered in combination with the Official Notice cited in the Final Office Action.